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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,340	11/16/2001	Paul England	MS1-955US	5780
22801	7590	11/01/2006	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			LEMMA, SAMSON B	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,340

Applicant(s)

ENGLAND ET AL.

Examiner

Samson B. Lemma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-11, 20-29, 41, 42, 49-53, 55-67 and 76-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11, 20-29, 41, 42, 49-53, 55-67 and 76-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in reply to an amendment filed on August 15, 2006 and claims 49 and 76 are amended. Claims 1-5, 7-11, 20-29, 41-42, 49-53, 55-67 and 76-79 are pending/examined

Response to Arguments

2. Applicant's argument filed on August 15, 2006 have been fully considered but they are not persuasive.

Referring to the independent claims, it has been argued that, Peterka, the reference on the record, does not disclose some of the limitation recited in the independent claims. Applicant wrote the following in support of his argument. Particularly, Peterka fails to disclose application data being of a non-migrateable type. "The Specification at page 29, lines 12-17, instructs as follows: Non-migrateable secrets ... are unconditionally non-migrateable - they cannot be transferred to another computing device. Non-migrateable secrets ... are encrypted by an encryption algorithm that uses, as an encryption key, non-migrateable key The trusted core will not divulge non-migrate able key ... to another computing device, so no other device will be able to decrypt trusted application secrets.... "

Applicant further wrote the following in support of his argument.

"Peterka, on the other hand, is directed to providing free program previews and/or other program content to clients, wherein encryptions keys are used to control client viewing (Abstract of Peterka). More to the point, Peterka is directed to disseminating program content to authorized (paying) clients. Peterka is completely devoid of any teachings directed to non-migrate able application data in any way or for any purpose as, under Peterka, all program content (arguably, "data") is migrate able to some authorized recipient(s). In fact, Peterka teaches directly away from

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the concept of non-migrate able application data, as Peterka is directed to providing (selling) any and all program content to as many clients as possible - see paragraph 0005 of Peterka.”

Examiner disagrees with the above argument. From the argument presented, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Though, the above recitation presented in the specification if written in the claims in the place of the term, “non-migrateable” would overcome the ground of the rejection, the rejection is maintained by virtue of broad interpretation of the term. Examiner interpretation of the term “Migrateable” data are data that can be accessed, transferred/moved or retrieved whereas “non-migrateable” data are contents that cannot be accessed/transferred/moved/retrieved.

In order to show how each and every limitation of the independent claim 1 is disclosed by the reference on the record, namely Peterka, the examiner would point out the following.

Referring to the independent claims, for instance, Peterka, the reference on the record, discloses a method comprising:

Receiving a request to transfer application data from a source computing device to a destination computing device;[figure 19, paragraph 0066, paragraph 0136]

Checking whether the application data can be transferred to the destination computing device[0066] (caching server examines the secure object of the client) and if so then

Checking whether the application data can be transferred under the control of user [paragraph 0136, “checking could be performed by the client] **or**

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a third party. [paragraph 0136, checking could be either performed by content providers/ caching server] **wherein, checking whether the application data can be transferred comprises checking a type of the application data,** [paragraph 0137,"analyzes the client's request for the program content] **the type of application data being one of non-migrateable** [paragraph 0137, content data which the clients are not authorized are non-migrateable,because such contents can not be accessed/transferred/moved/retrieved by the clients] **user-migrateable [paragraph 0136, checking by the client itself] and third party-migrateable.**[paragraph 0136, checking could be either performed by content providers/ caching server]

Receiving input from the appropriate one of the user or third party to control transferring of the application data to the destination computing device [paragraph 0136]

Therefore all the recited limitation of the independent claim is undoubtedly disclosed by the reference and the rejection is maintained until the applicant amends the independent claims and successfully overcome the rejection without introducing new matters.

The last argument presented by the applicant is towards the dependent claims. Examiner disagrees with the argument as the dependent claims stands and falls with the corresponding independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-5,7-11,20-29,41,42,49-53,55-67 and 76-79** are rejected under 35 U.S.C. 102(e) as being anticipated by **Peterka**. (hereinafter referred to as **Peterka**) (U.S. Publication No. 2002/0172368 A1) (Claims priority of provisional application, 60/243,92 filed on October 26, 2000)

5. **As per claim 1, 7-9, 20-26,41-42,49,52,55,59,61,63 and 76-79, Peterka** discloses a method comprising:

Receiving a request to transfer application data from a source computing device to a destination computing device;[figure 19, paragraph 0066, paragraph 0136]

Checking whether the application data can be transferred to the destination computing device[0066] (caching server examines the secure object of the client) and if so then

Checking whether the application data can be transferred under the control of user [paragraph 0136, "checking could be performed by the client] **or a third party.** [paragraph 0136, checking could be either performed by content

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providers/ caching server] wherein, checking whether the application data can be transferred comprises checking a type of the application data, [paragraph 0137,"analyzes the client's request for the program content] the type of application data being one of non-migreatable [paragraph 0137, content data which the clients are not authorized are non-migreatable] user-migrateable [paragraph 0136, checking by the client itself] and third party-migrateable.[[paragraph 0136, checking could be either performed by content providers/ caching server]

Receiving input from the appropriate one of the user or third party to control transferring of the application data to the destination computing device [paragraph 0136]

6. **As per claims 2,27,53 and 64, Peterka** discloses a method as applied to claim above. Furthermore **Peterka** discloses the method further comprising further comprising: checking whether the destination computing device is trusted to receive the application data; and preventing the application data from being transferred if the destination computing device is not trusted to receive the application data. [paragraph 0066,0142]

7. **As per claim 3, Peterka** discloses a method as applied to claim above. Furthermore **Peterka** discloses the method wherein,checking whether the destination computing device is trusted to receive the application data comprises checking whether software executing on the destination computing device is trusted to receive the application data. [paragraph 0066,0142]

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8. **As per claims 4-5, Peterka** discloses a method as applied to claim above.

Furthermore **Peterka** discloses the method, wherein checking whether the destination computing device is trusted to receive the application data comprises the third party checking whether the destination computing device is trusted to receive the application data.[paragraph 0136-0137]

9. **As per claim 10, Peterka** discloses a method as applied to claim above.

Furthermore **Peterka** discloses the method, further comprising: receiving application data to be encrypted and stored on the source computing device; identifying how the application data is to be allowed to be transferred to the destination computing device if a request to transfer the application data is received; and selecting a particular one of a plurality of encryption keys to encrypt the application data, wherein the selecting is based at least in part on how the application data is to be allowed to be transferred to another computing device.[paragraph 0142 & 0066]

10. **As per claims 11,28-29,56 and 65, Peterka** discloses a method as applied to claim above. Furthermore **Peterka** discloses the method, further comprising: further comprising: allowing application data for a plurality of applications to be transferred to the destination computing device by moving a single key to the destination computing device. [Paragraph 0066 & 0142]

11. **As per claims 50-51 and 77, Peterka** discloses a method as applied to claim above. Furthermore **Peterka** discloses the method, wherein the type of application secret is all secrets and the key associated with the one type is a gatekeeper storage key.[Paragraph 0066 & 0142]

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12. **As per claims 57, 66 and 78, Peterka** discloses a method as applied to claim above. Furthermore **Peterka** discloses the method, wherein the data comprises an operating secret.[Paragraph 0066 & 0142]

13. **As per claims 58, 67 and 79, England** discloses a method as applied to claim above. Furthermore **England** discloses the method, wherein the data comprises trusted core secret.[Paragraph 0066 & 0142]

14. **As per claims 60 and 62, Peterka** discloses a method as applied to claim above. Furthermore **Peterka** discloses the method, wherein the plurality of instructions to: encrypt an encryption key previously used to encrypt the data; and allow the encrypted key to be copied to the destination computing device.[Paragraph 0066 & 0142]

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is

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571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAMSON LEMMA

S.L.

10/26/2006



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